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EXAMINER

JANVIER, JEAN D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/296,120

Applicant(s)

REDDIN ET AL.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-19, 21-28, 3057, 59-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☒ Other: *Interview*.

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Response To Arguments

The rejection of claims 1-45, 46-52, 53 and 54-57, under 35 USC 101, for being directed to a manual process is still maintained as shown below. Moreover, the other rejections as submitted below are being maintained since the Applicant's arguments as herein presented are not persuasive.

DETAILED ACTION

Specification

Status of the claims

Claims 1-66 were originally presented. Claims 3, 20, 29 and 58 were canceled. Claims 1-2, 4-19, 21-28, 30-57 and 59-66 are now pending in the Instant Application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4-19, 21-28, 30-45, 46-52, 53, 54-57 and 59-65 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter for not being useful, tangible and concrete. In fact, the claimed invention in general, except for claim 66, pertains to an abstract idea. For example, claim 1 recites a process for determining one or more

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representative activities of said predetermined type of consumer without ever defining any previous activities or whether or not these activities are stored in a database and read therefrom, determining one or more representative uses of said item without ever defining whether or not these representative uses are read from the activities or transaction data compiled and stored in a database and creating demand for said item by said predetermined type of consumer without defining the intervening steps. Furthermore, the claim or claim 1 fails to recite important intervening steps; in other words, critical elements are missing from the claim language. The same remarks hold true for the other claims, as cited above.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

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affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Claims 1-2, 4-19, 21-28, 30-45, 46-52, 53 and 54-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. For example, the process or steps disclosed in independent claim 1 pertain to a manual process and therefore, the claims (claims 1-45) do not fall within the technological art. In other words, the steps or process of **determining one or more representative activities..., determining one or more representative uses... and creating demand for said item...**, as recited in claim 1, should be implemented via a device, such as a computer system, a database, a data communication, computer network, the Internet and so and so forth. Furthermore, the same remarks hold true for claims 46-52, claim 53 and claims 54-57.

Claim Objections

Claims 44-45 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of claims 1 and 39 respectively. Applicant is required to cancel claims 44-45, or amend claims 44-45 to place them in proper dependent form, or rewrite them in independent form.

[The steps of claims 1 and 39, as recited, should be incorporated within the bodies of claims 44-45 respectively and, upon executing proper computer instructions or codes by a computer processor, these steps can be performed. Hence, claims 44 and 45 must be canceled, amended or rewritten in independent form].

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-19, 21-28, 30-45, 46-52, 53 and 54-57 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. For instance, claim 1 jumps from the steps of determining one or more representative activities of a user and determining one or more representative uses of a product to creating demand for said product by the user without reciting important intervening, critical or essential steps necessary to the practice of the invention, especially when the steps of determining suffer from a sufficient disclosure. It is not clear how the process goes from the steps of determining to the final step of creating demand. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The same remarks hold true for the other claims, as cited above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-19, 21-28, 30-45, 46-52, 53 and 54-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention. For instance, claim 1 jumps from the steps of determining one or more representative activities of a user and determining one or more representative uses of a product to creating demand for said product by the user without reciting important intervening, critical or essential steps necessary to the practice of the invention, especially when the steps of determining suffer from a sufficient disclosure. **It is not clear how the process goes from the steps of determining to the final step of creating demand.** The same remarks hold true for the other claims, as cited above.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-2, 4-19, 21-28, 30-45, 53 and 59-65 drawn to a method or system for gathering consumer's market data and creating demand for a consumed item based upon representative uses of said item.

II. Claims 46-52 drawn to a method or system for gathering consumer's market data of a consumer regarding a consumed item, determining the manner in which said consumer selects the item in a shopping environment and creating demand for the consumed item based upon the manner in which the said item was selected by the consumer in the shopping environment.

III. Claims 54-57 and 66 drawn to a method or system for measuring or determining effectiveness of a marketing campaign related to an item by deploying solutions within a purchasing environment to create demand for said item by one or more shoppers.

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Here Inventions I, II and III, filed in a single Application, are related as Combination/subcombination separately usable for the reason noted above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed Invention for prosecution on the merits to which the claims shall be restricted.

Conclusion

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

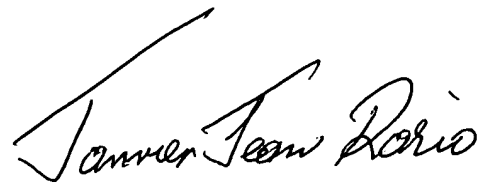
After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ
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Jean D. Janvier
Patent Examiner
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